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In re Application of	:	DECISION ON
SHI et al.	:	
Application No.: 09/701,309	:	PETITION UNDER
PCT No.: PCT/JP00/01754	:	
Int. Filing Date: 23 March 2000	:	37 CFR 1.47(a)
Priority Date: 31 March 1999	:	
Attorney Docket No.: L9289.00120	:	
For: COMMUNICATION TERMINAL	:	
APPARATUS, BASE STATION APPARATUS	:	
AND RADIO COMMUNICATION METHOD	:	

This is a decision on applicants' "PETITION UNDER 37 C.F.R. § 1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 26 March 2001.

BACKGROUND

On 23 March 2000, applicants filed international application PCT/JP00/01754, which claimed a priority date of 31 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 12 October 2000. The twenty-month period for paying the basic national fee in the United States expired at midnight on 31 November 2000.

On 28 November 2000, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than twenty months from the priority date.

On 26 December 2000, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. The NOTIFICATION set a one-month extendable period for reply.

On 26 March 2001, applicants submitted the instant petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*: a petition/fee for a two-month extension of time; surcharge under 37 CFR 1.492(e); an authorization to charge any fees which may be required to Deposit Account

19-4375; a declaration of inventors executed by two of the three joint inventors; a declaration of facts by Osamu Kato; cover letters of mailings sent to Mr. Shi on 08 February 2001 and 16 February 2001; and translations of Registered Record of Delivery for these mailings which indicate that these mailings were returned to the sender after a one-week custodial period due to absence of the recipient.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to (1), the fee of \$130.00 under 37 CFR 1.17(h) has been charged to Deposit Account 19-4375, as authorized in the transmittal letter accompanying the petition. It is noted that this transmittal letter also authorizes that the surcharge under 37 CFR 1.492(e) be charged to this Deposit Account. However, this surcharge was already paid on 26 December 2000 and thus has not been charged again. As to (3), a statement of the last known address of Mr. Shi has been provided. Item (4) has also been met.

As to (2), the petition does not include sufficient proof to establish that inventor Chi could not be found or reached after diligent effort. The translation of the first Registered Record of Delivery states that "[t]his mail is returned to a sender since a recipient was absent at the time of mail delivery". This translation also indicates a custodial period of seven days. The translation of the second Registered Record of Delivery states that "[t]his mail is returned to a sender since a custodial period of seven days under Article 90 of Post Office Rule expired." Thus, the items sent to Mr. Chi were available from the period of 09 February 2001 to 24 February 2001, a period of about two weeks. It is noted that Mr. Chi may simply have been on vacation during this time. It is noted that the fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

Also, from the translations of the Registered Record of Delivery, it is not clear exactly how this mail was attempted to be delivered. The translation of the first Registered Record of Delivery suggests that a delivery was attempted but Mr. Chi was not there at that time. It is not clear if any written communication was left at that address informing Mr. Chi that a package was attempted to be delivered and that such package would be held at the Post Office for a period of seven days. It is not clear from the translation of the second Registered Record of Delivery whether a delivery to the address was attempted or whether any written communication was left at that address indicating that a package for Mr. Chi would be held at the Post Office for a period of seven days. Thus, it is not clear whether Mr. Chi no longer resides at that address, was simply

not at that address during the period in question, or was not at that address on the first attempted delivery and simply failed to later pick up the delivery at the post office. Additionally, it is not clear whether any attempt was made to find a forwarding address if it was believed that Mr. Chi no longer resided at his last known address.

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(a) at this time.

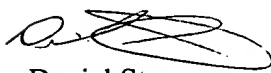
Also, it is noted that the declaration sent to Mr. Chi listed only Mr. Chi as an inventor and failed to list the other two inventors. Consequently, even if it had been signed by him, it would not have been in compliance with 37 CFR 1.497(a)-(b). Additionally, it is noted that if petitioner were attempting to establish a refusal of the inventor to execute the application (rather than attempting to establish that the inventor could not be found or reached after diligent effort), it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. See MPEP § 409.03(d). While the Exhibits include a copy of the application papers (specification, including claims, drawings, and oath or declaration), the translations of the cover letters and the petition fail to state that a copy of the specification was sent. Accordingly, if any additional papers are sent to Mr. Chi for signature, it is suggested that they at least include a declaration of inventors listing all of the inventors and a copy of the specification including claims, drawings, and abstract. Thus, if Mr. Chi is found but refuses to execute the application, at least these items will have been satisfied.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.



Daniel Stemmer
Legal Examiner

Application No.: 09/701,309

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